

## **Remarks**

### **I. INTRODUCTION**

Claims 21-23 have been added. Claims 11-23 are now pending in the present application. Amendments have been made to claims 11, 14, 16 and 19. Also, the Substitute Specification and the drawings have been amended. No new matter has been added.

Reconsideration of the present application is requested.

Applicants thank the Examiner for acknowledging the claim for foreign priority.

### **II. OBJECTIONS TO THE DRAWINGS**

The drawings were objected to for lacking labels. Figures 1-3 have been amended to include labels in accordance with the Examiner's suggestions. The amendments to the drawings are indicated in the attached replacement and annotated marked-up drawing sheets. Also, the drawings were objected under 37 C.F.R. § 1.83(a). The objection under 37 C.F.R. § 1.83(a) is respectfully traversed. It is respectfully submitted that the arrangement for new component detection and the arrangement for software error detection do not need to be shown because under 37 C.F.R. § 1.81 (a) -- to which § 1.83 (a) is subject, an applicant is only "required to furnish a drawing of his or her invention where necessary for the understanding of the subject matter sought to be patented". It is respectfully submitted that these arrangements are fully described by the specification, so that a drawing of these arrangements is not necessary. (See Specification, page 2, lines 8-16). It is therefore respectfully requested that the drawing objections be withdrawn.

### **III. OBJECTIONS TO THE SPECIFICATION**

The Specification was objected to due to various informalities. As indicated above, the Specification has been amended to correct these informalities as suggested by the Examiner. It is therefore respectfully requested that the objection to the specification be withdrawn.

### **IV. OBJECTIONS TO CLAIMS 14 AND 16**

Claims 14 and 16 have been objected to due to various informalities. Applicants have amended claims 14 and 16 in accordance with the Examiner's suggestions. This objection to the claims should be withdrawn.

### **V. REJECTION OF CLAIMS 11-20 UNDER 35 U.S.C. § 112, FIRST PARAGRAPH**

Claims 11-20 were rejected under 35 U.S.C. § 112, first paragraph, as lacking enablement.

Claims 11 and 19 have been amended to better clarify the subject matter of those claims. Claims 11 and 19, as amended, recite that a service element belongs to a distributed system that includes other components that are independent of one another and interconnected by a bus. Furthermore, claims 11 and 19 recite that the service element includes an arrangement for configuring the other components, an arrangement for upgrading the other components, an arrangement for maintaining the other components, and an arrangement for performing an emergency function. As described in the specification, “the service element of the present invention and the distributed system of the present invention have the advantage that the service element is able to carry out configurations, upgrades, maintenance, and, if necessary, emergency functions on the components of the distributed system.” (See Specification, page 1, lines 22-25). Additionally, as to claim 18, it is described in the specification that “[a] further refinement of the present invention provides for the service element of the present invention loading new software versions of software running on individual components of the distributed system, using a communication element available in the distributed system, and for the service element of the present invention initially checking the new software versions, in order to then configure them for the specific component.” (See Specification, page 2, lines 18-24). Also, the service element tests new software for errors by using test vectors, i.e., a predetermined value. (See Specification, page 7, lines 28-32). Thus, the specification and claims 11, 18, and 19 as understood by a person having ordinary skill in the art, satisfy the enablement requirement. Claims 12-18 depend from claim 11. Claim 20 depends from claim 19. Accordingly, it is respectfully submitted that the specification is enabling as to claims 11 to 20.

As further regards the enablement rejection under the first paragraph of 35 U.S.C. § 112, it is respectfully submitted that the standard for determining whether a patent application complies with the enablement requirement is that the specification describe how to make and use the invention -- which is defined by the claims. (See M.P.E.P. § 2164). The Supreme Court established the appropriate standard as being whether any experimentation for practicing the invention was undue or unreasonable. (See M.P.E.P. § 2164.01 (citing Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916); In re Wands, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed. Cir. 1988))). Thus, the enablement test is “whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” (See id. (citing United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988))).

The Federal Circuit has made clear that there are many factors to be considered in determining whether a specification satisfies the enablement requirement, and that these factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. (See id. (citing In re Wands, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407)). In this regard, the Federal Circuit has also stated that it is “improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors,” and that the examiner’s analysis must therefore “consider all the evidence related to each of these factors” so that any nonenablement conclusion “must be based on the evidence as a whole.” (See M.P.E.P. § 2164.01). It is respectfully submitted that the Office Action has not addressed these factors.

Importantly, an examiner bears the initial burden of establishing why the “scope of protection provided by a claim is not adequately enabled by the disclosure.” (See id. (citing In re Wright, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993))). Accordingly, a specification that teaches the manner and process of making and using an invention in terms that correspond in scope to those used in describing and defining the claimed subject matter complies with the enablement requirement. (See id.).

It is believed that the present assertions of the Office Action do not address whether the present application enables a person having ordinary skill in the art to practice the claimed subject matter of the claims without undue experimentation -- which it does. In short, it is believed that the Office Action’s arguments and assertions do not really address the issue of whether one having ordinary skill would have to *unduly experiment* to practice the claimed subject matter of the rejected claims -- a proposition for which the Office bears the burden of proving a prima facie case as to the rejected claims.

In this regard, to properly establish enablement or non-enablement, the Office must make use of proper evidence, sound scientific reasoning and the established law. In the case of Ex Parte Reese, 40 U.S.P.Q.2d 1221 (Bd. Pat. App. & Int. 1996), a patent examiner rejected (under the first paragraph of section 112) application claims because they were based on an assertedly non-enabling disclosure, and was promptly reversed because the rejection was based only on the examiner’s subjective belief that the specification was not enabling as to the claims. In particular, the subjective assertions of the Office Action are simply not supported by any real “evidence or sound scientific reasoning” -- which the law requires and which makes

plain that the Office (and not an applicant) bears the burden of persuasion on an enablement rejection.

More particularly, the examiner in Ex parte Reese was reversed because the rejection had only been based on a conclusory statement that the specification did not contain a sufficiently explicit disclosure to enable a person to practice the claimed invention without exercising undue experimentation -- which the Board found to be merely a conclusory statement that only reflected the subjective and unsupported beliefs of a particular examiner and that was not supported by any proper evidence, facts or scientific reasoning. (See id.). Moreover, the Board made clear that it is “incumbent upon the Patent Office . . . to back up assertions of its own with acceptable evidence,” and also made clear that “[where an] examiner’s ‘Response to Argument’ is not supported by evidence, facts or sound scientific reasoning, [then an] examiner has not established a *prima facie* case of lack of enablement under 35 U.S.C. § 112, first paragraph.” (See id. at 1222 & 1223; italics in original).

In the present case, it is respectfully submitted that the Office Action has not satisfied the foregoing for establishing that undue experimentation would be required, and it is therefore respectfully requested that the enablement rejection be withdrawn for all of the above reasons.

**VI. REJECTION OF CLAIMS 11-20 UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

Claims 11-20 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Claims 11 and 19 have been amended to better clarify the subject matter of those claims. It is respectfully submitted that claims 11-20 are now definite.

**VII. REJECTION OF CLAIMS 11, 12, 17, 19 AND 20 UNDER 35 U.S.C. § 102**

Claims 11, 12, 17, 19 and 20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,185,491 to Gray et al. (the "Gray patent"). It is respectfully submitted that the Gray patent does not anticipate any of claims 11, 12, 17, 19 and 20, for at least the following reasons.

Claim 11, as amended, recites the following:

A service element that belongs to a distributed system as a component, the distributed system includes other components that are independent of one another and interconnected by a bus, comprising:

- an arrangement for configuring the other components;
- an arrangement for upgrading the other components;

an arrangement for maintaining the other components; and  
an arrangement for performing an emergency function.

Claims 12 and 17 depend from claim 11. In accordance with the example embodiment described in the present application, “the service element of the present invention and the distributed system of the present invention have the advantage that the service element is able to carry out configurations, upgrades, maintenance, and, if necessary, emergency functions on the components of the distributed system.” (See Specification, page 1, lines 22-25).

The Gray patent does not describe or even suggest an arrangement for upgrading the other components and/or an arrangement for maintaining the other components. The system of the Gray patent purports to relate to the control of devices in a vehicle network. (See Gray, col. 1, lines 6-9). In particular, at col. 1, lines 44-51, the Gray patent describes that when a device is installed in a vehicle, a vehicle control center is aware of the installation and then requests or receives a stored interface from the installed device. The system in the Gray patent does not provide for upgrading and/or maintaining the components, it only provides for installation of a component and for installation of an interface for the component. In accordance with an example embodiment of the present invention, a distributed system includes components and a service element that has an arrangement for upgrading the other components and an arrangement for maintaining the other components.

In view of the foregoing, it is respectfully submitted that claims 11, 12, and 17 are not anticipated by the Gray patent.

Claim 19 recites that a distributed system includes components connected by a bus. One of the components is a service element that includes an arrangement for configuring the other components, an arrangement for equipping the other components, an arrangement for upgrading the other components, an arrangement for maintaining the other components, and an arrangement for performing an emergency function. Claim 20 depends from claim 19. For at least the same reasons discussed in connection with claim 1, the Gray patent also does not anticipate claims 19 and 20.

It is respectfully submitted that the rejection of claims 11, 12, 17, 19 and 20 should be withdrawn.

#### **VIII. REJECTION OF CLAIMS 13, 14 AND 18 UNDER 35 U.S.C. § 103**

Claims 13, 14 and 18 stand rejected under 35 U.S.C. § 103 as being obvious over the Gray patent in view of U.S. Patent No. 6,246,935 to Buckley (the "Buckley patent").

Claims 13, 14 and 18 depend from claim 11. As discussed above, the Gray patent does not describe or suggest all of the features of claim 11. Additionally, the Buckley patent at col. 1, lines 28-37 describes that a system for communication between a removable computer and an electrical system of a vehicle includes a communications interface operative for exchanging information between systems on the vehicle and the removable computer.

It is respectfully submitted that the Gray patent and the Buckley patent, whether taken alone or combined, do not in any way describe or suggest that a service element includes an arrangement for upgrading the other components and/or an arrangement for maintaining the other components.

Accordingly, it is respectfully submitted that claims 13, 14 and 18 are allowable for the same reasons as claim 11, since the Buckley patent does not cure the critical deficiencies of the Gray patent. The rejection of claims 13, 14 and 18 should therefore be withdrawn.

#### **IX. REJECTION OF CLAIMS 15 AND 16 UNDER 35 U.S.C. § 103**

Claims 15 and 16 stand rejected under 35 U.S.C. § 103 as being obvious over the Gray patent in view of the Buckley patent and further in view of U.S. Patent No. 6,330,499 to Chou et al. (the "Chou patent").

Claims 15 and 16 depend from claim 11. As discussed above, the Gray patent and the Buckley patent do not describe or suggest all of the features of claim 11. Additionally, the Chou patent at col. 1, lines 33-41 describes a system that extracts information provided by a vehicle internal monitoring system and then transfer the information to a remote service center in order to perform analysis of the information and provide information to a vehicle driver.

It is respectfully submitted that the Gray patent, the Buckley patent and the Chou patent, whether taken alone or combined, do not in any way describe or suggest that a service element is a component of a distributed system and is interconnected by a bus that includes one of an electrical wiring system, an optical wiring system, and a radio based system.

Accordingly, it is respectfully submitted that claims 15 and 16 are allowable for the same reasons as claim 11, since the Chou patent and the Buckley patent do not cure the critical deficiencies of the Gray patent. The rejection of claims 15 and 16 should therefore be withdrawn.

#### **X. NEW CLAIMS 21-23**

Claims 21-23 have been added herein. It is respectfully submitted that new claims 21-23 do not add any new matter and are fully supported by the present application, including the Specification. Since claims 21-23 ultimately depend from claim 11, it is respectfully submitted that

new claims 21-23 are patentable over the reference relied upon for at least the same reasons given above in support of the patentability of claim 11.

**XI. CONCLUSION**

Each of the issues raised by the Examiner has been addressed. It is respectfully submitted that the present application is in condition for allowance. Passage to issuance is requested.

Respectfully submitted,

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